

Appl. No. 10/623,125
Amdt. dated March 23, 2005
Reply to Office Action of December 23, 2004

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REMARKS

Applicant previously elected Group I, corresponding to claims 1-3, and 6 in response to a Restriction Requirement dated June 28, 2004. Applicant also canceled claims 4-5 in the response to the Restriction Requirement. Examiner, in paragraph 1 of the Office Action dated December 23, 2004 correctly reiterates the Group elected by the Applicant, but erroneously lists claims 2 and 3 as canceled. Applicant believes that the Examiner's listing of claims 2 and 3 as canceled is inadvertent, as the remainder of the Office Action is directed to claims 1-3 and 6. Applicant reiterates that claims 2-3 remain pending in the application and claims 4 and 5 were previously canceled in response to the Restriction Requirement.

Applicant, by this paper, amends claim 1 and adds new claims 7-10. Therefore, claims 1-3 and 6-10 are pending in the application and are presented for prompt allowance.

Discussion of Objections to the Specification

The Examiner objected to the Specification, paragraph [0031], at page 5, line 8 for referring to "the die 30" rather than "a die 30." Applicant amends paragraph [0031] in the manner suggested by the Examiner. Applicant respectfully requests withdrawal of the objection to the Specification in light of the amendment.

Discussion of Claim Rejections Under 35 USC §112

The Examiner rejected claims 1-3 and 6 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner identifies the language in claim 1 "a commercial die press including a working area with a cutting height; a consumer die adapted to be located in a cutting area of a consumer press" as allegedly unclear.

The Examiner alleges that "claim 1 claims both a commercial die press and a consumer press." *Office Action* paragraph 4, line 6-7. The Examiner then suggests that Applicant claim the characteristics or limitations of the consumer press. The Examiner also rejects claim 1 for lack of antecedent basis for the term "the consumer die press" and for not ending the claim with a period.

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Applicant amends claim 1 to use the term "consumer press" for which there is antecedent basis and to provide the proper punctuation at the end of the claim. Applicant respectfully traverses the rejection with respect to the description of the consumer die, and contends that claim 1 already describes the consumer die in relation the characteristics of the consumer die press, as suggested by the Examiner.

Claim is directed to a die press system, as recited in the preamble of the claim and does not claim "both a commercial die press and a consumer press" as suggested by the Examiner. The die press system of claim 1 includes "a commercial die press including a working area with a cutting height." Thus, this element of claim 1 includes a commercial die press and describes characteristics of the commercial die press. In particular, the commercial die press has a working area with a cutting height.

The die press system of claim 1 also includes "a consumer die adapted to be located in a cutting area of a consumer press." Thus, claim 1 does not claim a consumer press, as argued by the Examiner. Instead claim 1 includes an element, the consumer die, that is described in relation to the characteristics of a consumer press relative to the characteristics of the commercial die press. The characteristics of the consumer press are described in the claim element. Claim 1 describes "a consumer press with a cutting height smaller than the cutting height of the commercial press."

Thus, the die press system of claim 1 includes a commercial die press having particular characteristics, and a consumer die that is adapted for use in a consumer press having characteristics that are described in relation to the commercial die press. Because this is precisely how the Examiner suggests the Applicant describe the elements of the claim, Applicant respectfully request reconsideration and withdrawal of the rejection under 35 USC §112, in light of the amendment to correct antecedent basis and punctuation.

The Examiner provided no distinct rejections to claims 2-3 and 6, and the Applicant respectfully believes that the rejections to claims 2-3 and 6 are overcome with the amendment to claim 1. Applicant respectfully request reconsideration and withdrawal of the rejection of claims 2-3 and 6.

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Discussion of Claim Rejections Under 35 USC §102(b)

Claims 1-3 and 6 were rejected under 35 USC §102(b) as allegedly anticipated by U.S. Patent No. 5,778,748 to Beijen (hereinafter Beijen). The Examiner contends that the reference describes all of the claimed limitations.

In order for a claim to be anticipated by a reference, the reference describes each and every element as set forth in the claim, either expressly or inherently, in the single prior art reference. Applicant respectfully contends that Beijen fails to disclose at least one claimed element from each of claims 1-3 and 6.

Claim 1 includes "a commercial die press including a working area with a cutting height." Claim 1 also includes "a consumer die adapted to be located in a cutting area of a consumer press with a cutting height smaller than the cutting height of the commercial die press."

As described in claim 1, the commercial die press and the consumer press have different cutting heights. The cutting height of the consumer press is smaller than the cutting height of the commercial die press, and the consumer die is adapted to be located in the cutting area of the consumer press. As described in Applicant's specification, the consumer die may be utilized with the commercial press if an adapter is incorporated into the die combination to make up for the difference of the commercial die cutting height and the consumer die cutting height.

In contrast, Beijen does not describe different die presses having differing cutting heights. Instead, Beijen describes various embodiments of a roller activated die cutting machine using conventional dies. In fact, Beijen states: "All die cutting embodiments of this invention are designed for conventional dies 30." Beijen, Col. 6 ll. 18-19. Beijen describes a cutting die (reference no. 30) but does not describe cutting dies adapted for use with different cutting heights, nor does Beijen even suggest that the embodiments of the die presses can use cutting dies that are configured for cutting heights different from the cutting height provided by the die press.

The portions of Beijen cited by the Examiner merely describe the construction of the die press and describe how the cutting die is moved downward against the paper when the

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press is operated. Beijen fails to even describe cutting heights or the cutting heights associated with a cutting die.

Thus, because Beijen fails to disclose cutting heights or how a die press adapted for use with a consumer press having a particular cutting height can be used with a distinct commercial die press having a distinct and larger cutting height, Beijen fails to disclose, either expressly or inherently, every element of the claim. Applicant respectfully requests reconsideration and allowance of claim 1 in light of the failure of Beijen to disclose every claim element.

Claims 2-3 and 6 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2-3 and 6.

Discussion of Claim Rejections Under 35 USC §103(a)

Claims 1-3 and 6 were also rejected 35 USC §103(a) as allegedly unpatentable over Beijen. The Examiner states that "it would have been an obvious matter of design choice to provide the consumer press with a cutting height that is smaller than the cutting height of a commercial press or to provide the adapter with a height that compensates for the difference between the height of a commercial die and the height of the consumer press."

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Applicant respectfully traverses the rejection under 35 USC §103(a). As discussed above in relation to the rejection under 35 USC §102(b), Beijen fails to disclose each and every element of Claim 1. Additionally, there is no suggestion or motivation to modify the Beijen reference in a manner that would provide the die press system of claim 1.

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Beijen provides no description of the cutting height nor does Beijen describe cutting dies adapted to different cutting heights. The Examiner fails to identify a suggestion or motivation that would lead one of ordinary skill in the art to modify the teachings of Beijen to allow cutting dies adapted to a cutting height different from the cutting height of a commercial die press to be used in the commercial die press.

Beijen includes no discussion of cutting heights and the Examiner fails to identify a motivation or suggestion for considering cutting heights. Further, Beijen fails to describe cutting dies adapted to different cutting heights and the Examiner fails to identify motivation or suggestion for having cutting dies adapted to different cutting heights or for modifying a commercial die press to allow use of a cutting die adapted for a cutting height different from the cutting height of the commercial die press.

Therefore, because Beijen fails to disclose every claim limitation and there is no motivation or suggestion to modify the teachings of Beijen in a manner that would produce the die press system of claim 1, Applicant respectfully requests reconsideration and allowance of claim 1.

Claims 2-3 and 6 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2-3 and 6.

Discussion of New Claims

Claims 7-10 are added to the application. Support for the claims can be found throughout the specification. No new matter is added.

Claim 7 is an independent claim that describes the die without reference to a consumer die press. Claims 8-10 depend from claim 7 and provide additional limitations directed to the adapter. Support for the various claim limitations can be found, for example, at page 6 paragraphs [0035] and [0036] of the application, as filed.

Applicant respectfully requests allowance of new claims 7-10.

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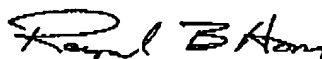
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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